

In the present amendment claims 7 and 20 have been cancelled due to amendment of claim 1. Claims 1 to 5, 8 to 11, 13 to 15 and 21 to 26 remain under prosecution.

Initially, it is noted that the previous rejection under 35 USC 112 has been withdrawn. Accordingly, no remarks are necessary that all claims comply with this section of Title 35.

Claims 1 to 5, 7 to 11, 13 to 15 and 20 to 26 stand rejected under 35 USC 102(e) as being anticipated by Shetty, et al. (Shetty), U.S. Patent 5,837,359.

The Office rejection directly states:

Shetty shows a film comprising at least one crystalline polyester coextruded layer of polyethylene terephthalate or polybutylene terephthalate and that only the outermost skin layers comprise titanium dioxide pigment (column 2, lines 12-15 and claim 1). Shetty shows that the layers comprise up to 12.5% of the pigment in the skin layers (column 3, lines 37-55). Shetty shows that the outermost skin layers are at least 5% of the total thickness of the film (ratio of thickness of 1 or more) (column 1, lines 59-67) and that the particles in the skin layers have a size of 12-15  $\mu\text{m}$  (column 2, lines 49-54).

This rejection is respectfully traversed and reconsideration is proper. Amended claim 1, the sole amended claim under prosecution, directly requires the pigment to have a particle size in the range of between 0.2  $\mu\text{m}$  and 1.0  $\mu\text{m}$ . In contrast, the Shetty publication in all instances discloses and requires the pigment particles to be in a range of 2 to 15 microns. More specifically, column 2, lines 49 to 54 and 59 to 61 states:

3. The pearlescent pigment particles should be small enough (2-15 microns) so that there can be a sufficient amount of pigments added to the polymers to achieve the desired haze levels (10 to 80%) and not encounter problems in maintaining a web during the film making process.

Both have all the above characteristics and the particle size range of these two pigments are in the 2 to 15 micron range.

Thus, in a closest comparison, the lower limit of Shetty of 2 microns is twice the nearly 1 micron upper limit of claim 1 (The upper 15 micron particle size disclosure of Shetty is 15 times the nearly 1 micron upper limit of claim 1).

It is noted that concerning the rejection under 35 USC 103 that the Office action cites *In re Boesch* as follows:

The experimental modification of prior art in order to optimize operation conditions (e.g. determine thickness and compositional proportions) fails to render claims patentable in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPC 215 (CCPA 1980).

In response, the problem and solution faced by Shetty differs from the problem and solution set forth in the present patent application. This prior art publication directly discloses use of pearlescent pigment in at least one interior layer to render a film non-glossy. The Examiner's attention is respectfully directed to the file of this patent namely "SATIN AND TINTED SATIN IRIDESCENT FILMS".

In contrast, certain critical parameters are present to obtain the beneficial results of the present invention. In addition to particle size, claim 1 requires at least one crystalline polyester layer containing more than 5 weight % of pigment and at least one crystalline polyester layer devoid of pigment. Thus, claim 1 sets forth use of two specific polyester layers which are crystalline. Claim 1 further requires a defined ratio of thickness of these two layers to one another. Furthermore, (although not specified in claim 1) a preferred pigment is a white pigment (disclosed on page 4, lines 8 and 9 of the present patent application).

Also, in the Abstract of the present patent application describes the product which is obtained, namely "The film shows good mechanical properties together with high opacity properties. Also, attention is respectfully directed to page 3, lines 10 to 13 of the patent application as follows:

The invention allows to combine the light transmission properties of a layer having a high pigment content together with the traditional mechanical properties of a layer substantially devoid of pigments.

Accordingly, the present invention (1) differs over the teachings of Shetty and (2) does not represent mere optimization. Any rejection either under 35 USC 102 or 35 USC 103 is not applicable.

Claims 6 and 16 to 19 stand rejected under 35 USC 103(a) as unpatentable over Shetty with citation of In re Boesch. The remarks made above directly refute a position of experimental modifications of prior art to optimize operation conditions.

Claim 12 stands rejected based on a combination of Shetty in view of Utsumi et al., U.S. Patent 5,510,192. In response, claim 12 represents a patentable advance in the art for the same reasons as parent claim 1. The secondary Utsumi et al. publication does not cure the deficiencies of Shetty.

In summary, a single independent claim is presented. A position has been taken in the present response that the introduction of a particle size requirement compiled with all other previous limitations into claim 1 results in a patentable advance in the art. Rejections under

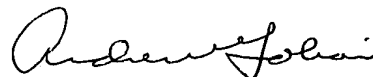
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35 USC 102 and 35 USC 103 are not applicable. With allowance of claim 1, all dependent claims are likewise allowable.

A notice of allowance is solicited.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

In showing the changes, deleted material is shown as brackets, and inserted material is shown underlining.

**IN THE CLAIMS:**

Amend claim 1 as follows:

1. A film comprising:

(i) at least one crystalline polyester layer containing more than 5 wt % of a pigment, and

(ii) at least one crystalline polyester layer devoid of pigment,  
where the ratio of the respective thickness of the layer devoid of pigment to the pigmented layer is at least 1 and

where the pigment has a particle size comprised between 0.02 and 1.0  $\mu\text{m}$ .